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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,863	08/02/2002	Ulrike Goerschel	01013.0089.00US00	6775

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EXAMINER

KOCH, GEORGE R

ART UNIT PAPER NUMBER

1734

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,863

Applicant(s)

GOERSCHEL ET AL.

Examiner

George R. Koch III

Art Unit

1734

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 6-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claim 6-11 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ezzo (US Patent 5,142,905).

Ezzo discloses a method for producing at least one test piece for testing an adhesive joint, comprising the steps of providing at least two joining parts (see Figure 2), each joining part comprising at least one joining edge and at least one projection (see Figures 2 and 3) formed integrally to the joining part and having a test edge, positioning the joining parts so that at least one joining edge and at least one test edge of each joining part overlap at least partially, forming the adhesive joint in a region between at least one joining edge and at least one test edge of the joining parts, severing the at least one of the joined projections from the joining parts (see column 6, lines 66-68), providing at least one of the severed projections as a test piece.

Ezzo does not disclose providing at least one of the severed joining parts for non-test purposes, or in other words, manufacturing joining parts and providing several test specimens or samples for further test purposes.

Chang discloses providing at least one of the severed joining parts for non-test purposes. Chang discloses, for example, in claim 30, manufacturing a substrate and cutting the substrate to form a test sample of the overall substrate (see also column 6-7). One in the art would appreciate that such an analysis gives a more accurate measurement of the part properties, since the sample element would be made under identical conditions. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a step of providing at least one of the severed joining parts for non-test purposes, i.e., manufacturing joining parts and

providing several test specimens or samples for further test purposes, in order to achieve the most accurate representation of the end product created.

As to claim 7, Ezzo discloses that the severed test piece is divided into a plurality of test piece sections.

As to claims 8 and 9, Ezzo discloses that the adhesive joint is formed along a single edge comprising a joining edge and a test edge of each joining part.

As to claim 10, Ezzo discloses that at least one adhesive seam is formed by the adhesive joint.

As to claim 11, Ezzo discloses that the projections are severed approximately perpendicularly to the adhesive seam, i.e., at the break lines (BL, see column 6, lines 66-68).

Claim 13 is rejected on similar grounds as claim 6 above. Ezzo discloses proving two parts, each part comprising a projection (see Figures 2-4), positioning the parts so that at least a portion of the parts overlap, the overlapping portions including at least a portion of the projections, forming the adhesive joint in a region between the overlapping portions (see Figure 4, for example), severing the joined projections from the joined parts, and testing the adhesive joint formed between the severed projections to determine the properties of the adhesive joint formed between the joined parts (see column 5, lines 38-41).

Ezzo does not disclose providing at least one of the severed joining parts for non-test purposes, or in other words, manufacturing joining parts and providing several test specimens or samples for further test purposes.

Chang discloses providing at least one of the severed joining parts for non-test purposes. Chang discloses, for example, in claim 30, manufacturing a substrate and cutting the substrate to form a test sample of the overall substrate (see also column 6-7). One in the art would appreciate that such an analysis gives a more accurate measurement of the part properties, since the sample element would be made under identical conditions. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a step of providing at least one of the severed joining parts for non-test purposes, i.e., manufacturing joining parts and providing several test specimens or samples for further test purposes, in order to achieve the most accurate representation of the end product created.

Claim 14 is rejected on similar grounds as claim 7 above.

Claim 15 is rejected on similar grounds as claim 8 above. The single edge extends along a portion of the projection.

Claim 16 is rejected on similar grounds as claim 10 above.

Claim 17 is rejected on similar grounds as claim 11 above.

5. Claims 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ezzo and Chang as applied to claims 6 and 13 above, and further in view of Matsen (US 5,847,375).

Ezzo and Chang as applied to claims 6 and 13 above do not disclose that the joining parts comprise a fiber reinforced materials. However, Ezzo does suggest that the method disclosed is intended for used with aerospace industry materials (column 1,

Art Unit: 1734

lines 37-40). One in the art would appreciate that Ezzo intends for the suggested method to be used with any aerospace industry product.

Matsen discloses that aerospace industry products are frequently manufactured from composite materials (see column 1, lines 25 through column 2, line 45). Matsen discloses such materials include reinforcing fibers in uncured matrix resin, i.e., a fiber reinforced material. Matsen discloses that such materials are popular in aerospace industries, and often involve bonding steps (i.e., through the use of the resin, disclosed in passage cited above). One in the art would then appreciate that Ezzo's method can be used with fiber reinforced or composite materials. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a fiber reinforced material as the material in question as such materials are conventionally used in aerospace industries.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Koch III whose telephone number is (703) 305-3435 (TDD only). If the applicant cannot make a direct TDD-to-TDD call, the applicant can communicate by calling the Federal Relay Service at 1-800-877-8339 and giving the operator the above TDD number. The examiner can normally be reached on M-Th 10-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone

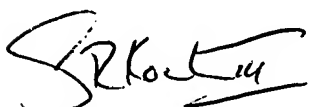
Application/Control Number: 10/088,863

Page 7

Art Unit: 1734

number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



George R. Koch III
September 24th, 2003



RICHARD CRISPINO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700